



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/801,679

03/17/2004

Tomotsune Nishimura

A453-1

3334

21254

7590

02/06/2008

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

EXAMINER

KESSLER, MATTHEW E

ART UNIT

PAPER NUMBER

4121

MAIL DATE

DELIVERY MODE

02/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/801,679	Applicant(s) NISHIMURA, TOMOTSUNE	
	Examiner MATTHEW E. KESSLER	Art Unit 4121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/17/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/3/06, 9/8/04, 3/17/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-22 are pending.
2. Claims 1-22 are rejected.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 19-22 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. The applicant has directed his invention to "a program for causing a computer to carry out a method". This is not a statutory category of invention. Although the applicant has stated in the specification that the program may be stored on a computer readable medium which is directed towards a statutory category, the applicant has used the optional language "may". Thus there exists the situation in which the program for causing a computer to carry out a method is not stored on a computer readable medium and is thus non-statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Schwartz Patent Application Number 2002/0091777 (Schwartz hereinafter).

As to claim 1, Schwartz teaches a method of automatically replying to a received e-mail (Paragraph [0001] teaches “Method and system for automatically generating a message reply and file.”) in a mobile terminal having a function of transmitting and receiving an e-mail (Paragraph [0003] teaches “an electronic message, whether it is a text based e-mail, a facsimile image, a video, or a voice message, is generated by a user at a computer or other suitable wired or **wireless electronic device** such as, for example, a personal digital assistant, **a telephone**, a charge coupled device (CCD), or a facsimile machine.”), comprising the step of automatically transmitting image data determined in accordance with an address of a transmitter of said received e-mail, to said address (Paragraph [0014] teaches “reply messages and reply files are stored at an associated message server or a database or other peripheral in communication therewith. The recipient may generate or have generated for her a standard reply message and reply file to be sent to all electronic message senders, may select from one or more standard reply messages and files, **or may generate sender-specific reply messages and files**”).

As to claim 2, Schwartz teaches the method as set forth in claim 1, wherein said image data is edited in accordance with said address (Paragraph [0013] teaches the reply messages including a reply message and a file

Art Unit: 4121

associated with the reply message which can be associated in accordance to the sender or recipient's address. Furthermore paragraph [0015] teaches that the associated files can be of an image file format. It is interpreted that selecting an image to be attached to the automatically generated reply is editing the image data to be sent to the said address. The data specifying the image is edited according to the address of whom the reply is being sent to.).

As to claim 3, Schwartz teaches the method as set forth in claim 1, wherein said image data is comprised of moving-image data (Paragraph [0015] teaches the file associated with the reply message as a video file.).

As to claim 4, Schwartz teaches the method as set forth in claim 1, wherein text data determined in accordance with said address is automatically transmitted together with said image data (Paragraph [0022] teaches “In keeping with the invention, the stored replies may be text, audio, graphics, video, facsimile image, or **any combination thereof**, or other suitable information type.).

As to claim 5, Schwartz teaches the method as set forth in claim 1, further comprising the step of determining whether said image data is automatically transmitted in response to said received e-mail (Paragraph [0028] teaches “On receipt of the message at the message server 16, the message server or other electronic equipment in communication therewith, will associate the message with a specific recipient and cross reference the recipient's user profile, and in

Art Unit: 4121

particular, both the user's reply message profile and reply file profile, **to determine what, if any, reply message or messages and attached files should be generated and the corresponding address or addresses where the reply messages and reply files should be sent.**").

As to claim 6, Schwartz teaches a method of automatically replying to a received e-mail (Paragraph [0001] teaches "Method and system for automatically generating a message reply and file.") in a mobile terminal having a function of transmitting and receiving an e-mail (Paragraph [0003] teaches "an electronic message, whether it is a text based e-mail, a facsimile image, a video, or a voice message, is generated by a user at a computer or other suitable wired or **wireless electronic device** such as, for example, a personal digital assistant, **a telephone**, a charge coupled device (CCD), or a facsimile machine."), comprising the steps of:

(a) checking whether an address of a transmitter of a received e-mail is stored in a memory (Paragraph [0029] teaches "The automated method for generating a reply message and/or reply file to a sender includes **storing** 22 a reply message to a message sent having a selected recipient address and at least one **sender address.**" Storing a reply message to a sender address inherently includes storing the sender address.);

(b) checking whether image data associated with said address is stored in said memory (Paragraph [0029] teaches "The method further includes **storing** 23 a **reply file** to be sent to the sender, preferably, but not necessarily, by

Art Unit: 4121

attachment to the message reply.” Paragraph [0015] taught the file as an image or other file type.); and

(c) transmitting said image data to said address (Paragraph [0029] teaches “Finally, the method includes automatically forwarding 24 the reply message and reply file to the sender.”).

As to claim 7, Schwartz teaches the method as set forth in claim 6, further comprising the step of (d) judging whether it is determined to automatically transmit image data determined in accordance with said address, to said transmitter (Paragraph [0028] teaches “**determine what, if any, reply message or messages and attached files should be generated** and the corresponding address or addresses where the reply messages and reply files should be sent.”), said step (d) being carried out prior to said step (a) (In Paragraph [0028] the phrase “if any” shows that the determination of whether or not an automatically generated reply message would be sent or not is determined before it searches the storage. If the determination was made after it searched, there would be no need for Schwartz to give the scenario where the electronic message or address didn't exist in the storage.).

As to claim 8, Schwartz teaches the method as set forth in claim 6, further comprising the steps of (e) checking whether text data associated with said address is stored in said memory, wherein said text data is transmitted to said address together with said

image data in said step (c) (Paragraph [0029] teaches “Finally, the method includes automatically forwarding 24 the reply message and reply file to the sender.” The message, i.e. text, and the file, i.e. image, are being sent together.).

As to claim 9, Schwartz teaches the method as set forth in claim 6, further comprising the step of (f) editing said image data in accordance with said address (Paragraph [0013] teaches the reply messages including a reply message and a file associated with the reply message which can be associated in accordance to the sender or recipient's address. Furthermore paragraph [0015] teaches that the associated files can be of an image file format. It is interpreted that selecting an image to be attached to the automatically generated reply is editing the image data to be sent to the said address. The data specifying the image is edited according to the address of whom the reply is being sent to.).

As to claim 10, Schwartz teaches the method as set forth in claim 6, wherein said image data is comprised of moving-image data (Paragraph [0015] teaches the file as being a video.).

As to claim 11, Schwartz teaches a mobile terminal having functions of transmitting and receiving an e-mail (Paragraph [0003] teaches “an electronic message, whether it is a text based e-mail, a facsimile image, a video, or a voice message, is generated by a user at a computer or other suitable wired or **wireless electronic**

Art Unit: 4121

device such as, for example, a personal digital assistant, **a telephone**, a charge coupled device (CCD), or a facsimile machine.”), and automatically replying to a received e-mail (Paragraph [0001] teaches “Method and system for automatically generating a message reply and file.”), comprising a controller for automatically transmitting image data determined in accordance with an address of a transmitter of said received e-mail (Paragraph [0014] teaches “reply messages and reply files are stored at an associated message server or a database or other peripheral in communication therewith. The recipient may generate or have generated for her a standard reply message and reply file to be sent to all electronic message senders, may select from one or more standard reply messages and files, **or may generate sender-specific reply messages and files**”).

As to claim 12, Schwartz teaches the mobile terminal as set forth in claim 11, wherein said controller edits said image data in accordance with said address (Paragraph [0013] teaches the reply messages including a reply message and a file associated with the reply message which can be associated in accordance to the sender or recipient's address. Furthermore paragraph [0015] teaches that the associated files can be of an image file format. It is interpreted that selecting an image to be attached to the automatically generated reply is editing the image data to be sent to the said address. The data specifying the image is edited according to the address of whom the reply is being sent to.).

As to claim 13, Schwartz teaches the mobile terminal as set forth in claim 11, wherein said image data is comprised of moving-image data (Paragraph [0015] teaches the file associated with the reply message as a video file.).

As to claim 14, Schwartz teaches the mobile terminal as set forth in claim 11, wherein text data determined in accordance with said address is automatically transmitted together with said image data (Paragraph [0022] teaches “In keeping with the invention, the stored replies may be text, audio, graphics, video, facsimile image, or **any combination thereof**, or other suitable information type.).

As to claim 15, Schwartz teaches the mobile terminal as set forth in claim 11, wherein said mobile terminal is comprised of a cellular phone (Paragraph [0003] teaches “an electronic message, whether it is a text based e-mail, a facsimile image, a video, or a voice message, is generated by a user at a computer or other suitable wired or **wireless electronic device** such as, for example, a personal digital assistant, **a telephone**, a charge coupled device (CCD), or a facsimile machine.”).

As to claim 16, Schwartz teaches the mobile terminal as set forth in claim 11, wherein said controller includes a data processor and a memory (Paragraph [0020] teaches “As indicated above, sending and receiving devices 12 and 14, respectively, may be any electronic device capable of generating and/or receiving and

Art Unit: 4121

displaying messages such as, for example, a desktop computer, a notebook computer, a personal digital assistant, a telephone, a charge coupled device such as a wired or wireless digital camera, a facsimile machine, a printer, etc.” inherent to any of these electronic devices is a data processor. Inherent to any electronic device capable of generating and/or receiving and displaying messages is a data processor. Additionally paragraph [0029] teaches the messages received are stored. These messages are taught as including the sender and recipient address and as such the address is stored. Paragraph [0029] also teaches the attachment files being stored. Inherent to an electronic device which is storing information is memory.),

said memory including a first memory area for storing addresses to which an e-mail is automatically transmitted (Paragraph [0029] teaches “The automated method for generating a reply message and/or reply file to a sender includes **storing 22** a reply message to a message sent having a selected recipient address and at least one **sender address**.” Storing a reply message to a sender address inherently includes storing the sender address.), and a second memory area for storing moving-data to be edited by a user of said mobile terminal for each of said addresses (Paragraph [0029] teaches “The method further includes **storing 23 a reply file** to be sent to the sender, preferably, but not necessarily, by attachment to the message reply.” Paragraph [0015] teaches “In keeping with the invention, the reply files may comprise any suitable file including, without limitation, a text file (e.g. Microsoft Word, Corel Wordperfect, etc.), a still image (e.g. JPEG, GIF, TIFF, PICT, EPS, PDF, PNG, DCF, DPOF, FLASHPIX, etc.) an audio clip (e.g. MPEG, MPEG II, MPEG III, MPEG IV etc.), a **video clip**, an Internet link, etc.”),

Art Unit: 4121

said data processor including a first retriever which retrieves said addresses stored in said first memory area, and a second retriever which retrieves said moving-data stored in said second memory area (Paragraph [0028] teaches generating a message according to the stored addresses and files. Generating the message inherently includes fetching the stored information.).

As to claim 17, Schwartz teaches the mobile terminal as set forth in claim 16, wherein said memory further includes a third memory area for storing a message to be edited by said user, and said data processor further includes a third retriever which retrieves said message stored in said third memory area (Paragraph [0029] teaches “The automated method for generating a reply message and/or reply file to a sender includes **storing** 22 a reply message to a message sent having a selected recipient address and at least one **sender address**.” Storing a reply message to a sender address inherently includes storing the sender address. Additionally the stored message can be edited by adding a file to the message.).

As to claim 18, Schwartz teaches the mobile terminal as set forth in claim 11, wherein said controller includes a unit for determining whether said image data is automatically transmitted in response to said received e-mail (Paragraph [0028] teaches “On receipt of

Art Unit: 4121

the message at the message server 16, the message server or other electronic equipment in communication therewith, will associate the message with a specific recipient and cross reference the recipient's user profile, and in particular, both the user's reply message profile and reply file profile, **to determine what, if any, reply message or messages and attached files should be generated and the corresponding address or addresses where the reply messages and reply files should be sent.**”).

As to claim 19, Schwartz teaches A program for causing a computer to carry out a method of automatically replying to a received e-mail (Paragraph [0001] teaches “Method and system for automatically generating a message reply and file.” Schwartz teaches the methods being performed in a computer system and inherent to performing these methods would be a program.) in a mobile terminal having a function of transmitting and receiving an e-mail (Paragraph [0003] teaches “an electronic message, whether it is a text based e-mail, a facsimile image, a video, or a voice message, is generated by a user at a computer or other suitable wired or **wireless electronic device** such as, for example, a personal digital assistant, **a telephone**, a charge coupled device (CCD), or a facsimile machine.”), wherein steps executed by said computer in accordance with said program include automatically transmitting image data determined in accordance with an address of a transmitter of said received e-mail, to said address (Paragraph [0014] teaches “reply messages and reply files are stored at an associated message server or a database or other peripheral in communication therewith. The

recipient may generate or have generated for her a standard reply message and reply file to be sent to all electronic message senders, may select from one or more standard reply messages and files, **or may generate sender-specific reply messages and files**").

As to claim 20, Schwartz teaches a program for causing a computer to carry out a method of automatically replying to a received e-mail (Paragraph [0001] teaches "Method and system for automatically generating a message reply and file." Schwartz teaches the methods being performed in a computer system and inherent to performing these methods would be a program.) in a mobile terminal having a function of transmitting and receiving an e-mail (Paragraph [0003] teaches "an electronic message, whether it is a text based e-mail, a facsimile image, a video, or a voice message, is generated by a user at a computer or other suitable wired **or wireless electronic device** such as, for example, a personal digital assistant, **a telephone**, a charge coupled device (CCD), or a facsimile machine."), wherein steps executed by said computer in accordance with said program include:

(a) checking whether an address of a transmitter of a received e-mail is stored in a memory (Paragraph [0029] teaches "The automated method for generating a reply message and/or reply file to a sender includes **storing** 22 a reply message to a message sent having a selected recipient address and at least one **sender address**." Storing a reply message to a sender address inherently includes storing the sender address.);

(b) checking whether image data associated with said address is stored in said memory (Paragraph [0029] teaches “The method further includes **storing 23 a reply file** to be sent to the sender, preferably, but not necessarily, by attachment to the message reply.” Paragraph [0015] taught the file as an image or other file type.); and

(c) (c) transmitting said image data to said address (Paragraph [0029] teaches “Finally, the method includes automatically forwarding 24 the reply message and reply file to the sender.”).

As to claim 21, Schwartz teaches The program as set forth in claim 20, wherein said steps further include (d) judging whether it is determined to automatically transmit image data determined in accordance with said address, to said transmitter (Paragraph [0028] teaches “**determine what, if any, reply message or messages and attached files should be generated** and the corresponding address or addresses where the reply messages and reply files should be sent.”), said step (d) being carried out prior to said step (a) (In Paragraph [0028] the phrase “if any” shows that the determination of whether or not an automatically generated reply message would be sent or not is determined before it searches the storage. If the determination was made after it searched, there would be no need for Schwartz to give the scenario where the electronic message or address didn't exist in the storage.).

As to claim 22, Schwartz teaches The program as set forth in claim 20, wherein said steps further include (e) checking whether text data associated with said address is stored in said memory, wherein said text data is transmitted to said address together with said image data in said step (c) (Paragraph [0029] teaches “Finally, the method includes automatically forwarding 24 the reply message and reply file to the sender.” The message, i.e. text, and the file, i.e. image, are being sent together.).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Peek et al., US Patent Number 6292799, directed to automatic voicemail reply;

Aktas et al., US Patent Number 6459776, directed to sending personalized greeting replies, see FIG. 4;

Krueger et al., US Patent Application Number 2001/0004743, directed to messages generated with images, see FIG. 9;

Nakano, US Patent Application Number 2002/0039095, directed to a mobile terminal with email capabilities and images;

Pedersen, US Patent Application Number 2002/0118807, directed to callee specific messages, see FIG. 6;

.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW E. KESSLER whose telephone number is (571)270-5005. The examiner can normally be reached on Monday through Friday 7:30 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Taghi Arani can be reached on (571)272-3787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MK/

/Taghi T. Arani/
Supervisory Patent Examiner, Art Unit 4121
2/2/2008